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Remarks

Claims 1-17 and 19 are pending in the application. All claims stand rejected. By this paper, independent claims 1, 12, and 15 have been amended. Reconsideration of all pending claims is respectfully requested.

35 U.S.C. § 103

Claims 1-11, 15-17, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,351,467 to Dillon ("Dillon") and U.S. Patent No. 5,861,881 to Freeman et al. ("Freeman").

As amended herein, claim 1 recites the limitation of "concurrently selecting and extracting a subset of multimedia streams of said plurality of multimedia streams by identifying and extracting each packet in said plurality of multimedia streams that has a specific characteristic." Support for this limitation is found in page 12 and page 22, lines 18-25.

As stated in the Office Action, Dillon does not show selecting and extracting a subset of multimedia streams of said plurality of multimedia streams. Office Action of May 15, 2006, page 3.

Freeman teaches the insertion of a user selected audio segment, video segment, or graphic at a trigger point. Column 13, lines 5-45. The trigger point commands a switch to a branch of the particular video audio stream. Column 13, lines 37-45. However, Freeman does not teach or suggest concurrently selecting and extracting a subset of multimedia streams. Rather, Freeman branches to an individual stream. Indeed, Freeman is not concerned with concurrently selecting and

extracting multiple multimedia streams, as the trigger point is to initiate branching to a single stream.

The distinction between the claimed invention and Freeman is apparent. Freeman is concerned with providing an interactive and customizable multimedia presentation. Freeman teaches only selecting one stream for each trigger point. Freeman does not teach concurrently selecting and extracting desired multimedia streams. The claimed limitation requires concurrent selection and extraction of multiple streams with the specific characteristic. This follows as the claimed invention is directed to distribution of a variety of channels, not customizing or editing a single presentation.

Because Dillon and Freeman fail to disclose the discussed limitations, they cannot obviate the independent claims. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03.

Independent claims 12 and 15 recite similar limitations and represent patentable subject matter for at least the reasons discussed above.

Claim 13 also requires that an advertiser pays a fee related to an amount of time that the digital information will be cached in the broadcast receiver systems. For this limitation, the Office Action cites to usage reporting in Dillon. Column 24, lines 45 to column 25, line 12 and column 27, line 55 to column 28, line 35. As previously discussed, the cited passages discuss revenues being generated based on a website recording hits such as: (i) the number of hits a site receives, or (ii) a forecast of anticipated hits. Column 24, lines 55-64. There is absolutely no discussion of fees

related to the amount of time that digital information is cached in a receiver system. Dillon completely fails to disclose this limitation. Freeman also fails to teach this limitation.

A website recording hits for compensation is not compensation based on the amount of time digital information is cached. Time-based caching and website hits are completely different revenue models. The Office Action fails to note this important distinction.

A website may record numerous hits to generate significant revenues, yet there is no tracking of how long information remains cached in a receiver. A receiver may cache digital information for an extended period of time to generate revenue, but this does not depend on the number of hits to a website. Claim 13 recites a revenue model that is not taught by Dillon. The well-established revenue model of recording website hits for compensation fails to teach time-based caching of digital information in a receiver.

Claim 14 also requires that advertiser pays a fee related to an amount of said designated digital information. Dillon teaches fees based on channel subscription. Channel subscription provides unlimited access and is not based on an amount of digital information. Furthermore, a user pays a subscription fee to view, whereas claim 14 recites an advertiser paying a fee to distribute. Dillon further discloses revenue based on reporting website hits. Recording the number of website hits does not satisfy the requirement of a fee based on an amount of cached digital information. When tracking the number of website hits, the amount of digital information downloaded is irrelevant. Recording an amount of cached digital

information is independent of the number of hits to a website. A large or small amount of digital information may be downloaded in a single website hit. This limitation is not met by Dillon.

Claim 15 also recites searching a cache and a server system for matching multimedia streams that match a query. For this limitation, the Office Action cites to Figure 8 and column 22, lines 18-61 for content matching. The cited passage in Dillon discloses finding URLs in a cache. A URL is not a multimedia stream. Streaming media is defined as media that is consumed while it is being delivered to provide a media experience. <http://en.wikipedia.org>. A media stream is advantageous because the media may be played as the stream arrives rather than requiring an entire download before play begins. A URL is a sequence of characters conforming to a standardized format, that is used for referring to resources on the Internet by their location. <http://en.wikipedia.org>.

A URL is incapable of providing audio or video and does not play to provide audio or video as it is received. A URL simply points to Internet locations. Locating a multimedia stream allows the playback of multimedia. Locating a URL provides an Internet address. Dillon does not teach querying a cache or server system for multimedia streams.

Claim 15 further recites a query response that comprises matching multimedia streams. As Dillon does not teach searching for multimedia streams, Dillon also does not teach a response that includes multimedia streams. Instead, Dillon teaches locating URLs. These limitations are not taught in Dillon or in Freeman and the Office Action fails to cite an anticipatory reference.

No Motivation to Combine References

The Applicant further submits that Dillon and Freeman provide absolutely no motivation to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In re Mills, 916 F.2d 680, 683, 16 USPQ2d 1430, 1433 (Fed. Cir. 1990). "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination." ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The suggestion to combine must come from the cited references themselves, not from common knowledge and common sense.

The "common knowledge and common sense," on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act . . . The Board's findings must extend to all material facts and must be documented on the record, lest the "haze of so-called expertise" acquire insulation from accountability. "Common knowledge and common sense," even if assumed to derive from the agency's expertise do not substitute for authority when the law requires authority.

In re Lee, 277 F.3d, 1338, 1344-1345, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Furthermore, in order to establish prima facie obviousness, there must be evidence of the motivation to combine. "When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness." Id. at 1343, 61 USPQ at 1433 (emphasis added).

The Office Action cites elements in Dillon and Freeman. "However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The Office Action cites no evidence of the motivation, suggestion, or teaching to combine Dillon and Freeman. This evidence must come from Dillon and Freeman themselves.


The Applicant cannot find any motivation, suggestion, or teaching in the cited references for combination. Dillon is directed to multicasting channels to receivers in a multicast network. Abstract. Freeman is directed to personalizing graphics, video, and/or audio presentations in response to user inputs. Abstract. Dillon is not concerned with editing, customizing, or personalizing the channels that its system multicasts. Freeman is not concerned with multicasting channels. Although elements may be selected from both Dillon and Freeman, there is no evidence of a motivation to combine. Merely citing elements in each reference is insufficient to establish a *prima facie* case of obviousness. Reconsideration is respectfully requested.

The remaining claims depend from and include all limitations of either claims 1, 12, or 15 and likewise represent patentable subject matter. In view of the foregoing, all pending claims are in condition for allowance. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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